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REMARKS

The Examiner is thanked for the courtesies extended to the undersigned in telephone conversations on January 17 and February 3, 2006, during which the enclosed Supplemental Information Disclosure Statement (IDS) and the procedural posture of the present application were discussed.

The Supplemental IDS is submitted to bring to the Examiner's attention a family of patents and patent applications that are commonly assigned with the present application and whose subject matter is related to the present application. The present application does not claim priority under 35 U.S.C. § 120 to any of the patents and applications that are cited in the Supplemental IDS; however, the cited patents and applications also describe bimodal ionomer compositions and golf balls and golf ball parts that comprise these compositions.

Claim 8 is amended herein to rectify an apparent typographical error. This amendment is purely formal and unrelated to patentability. It is also believed that the amendment introduces no new matter into the application.

In addition, new claims 23 to 31 are presented herein. These claims correspond to original claims 3 to 11; however, the new claims depend directly from claim 1. Thus, they need not incorporate the features of claim 2, specifically, that the cover further comprise at least one additional polymeric component having a M_w of from about 80,000 to about 500,000. A basis for the new claims may be found in the specification on page 8 at lines 18 to 21 (claims 23 and 24); page 9 at lines 13 to 16 (claims 25 and 26); page 9 at lines 16 to 20 (claims 27 and 28); page 22 at lines 4 and 5 (claim 29); page 25 at lines 20 to 24 (claims 30 and 31); in the Examples of the invention and in the claims as originally filed, *inter alia*. Accordingly, it is believed that these new claims do not introduce any new matter into the application.

Finally, Applicant withdraws the Notice of Appeal filed on November 16, 2005.

Turning now to the Advisory Action issued on November 14, 2005, the assertion that claims 1 and 12 are obvious under 35 U.S.C. §103(a) in view of U.S. Patent Appln. Publn. No. 2004/0209705 by Rajagopalan et al. (hereinafter "Rajagopalan") has been repeated. The Advisory Action states that the reasons for this assertion are the same as those set forth in the final Official Action of May 16, 2005.

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Applicant respectfully traverses this rejection. The arguments and reasoning submitted previously in the prosecution are neither withdrawn nor abandoned. In addition, Applicant respectfully submits the following facts and reasoning.

Supposing, *arguendo*, that Rajagopalan describes the comonomer composition that is recited in claims 1 and 12, but includes no molecular weight information, the bimodal composition that is featured in Applicant's claims may be viewed as a subgenus of the generic composition described in Rajagopalan. (Applicant does not consider this supposition to be completely accurate, however. For example, the Response under 37 C.F.R. § 1.116 explains at length that the copolymers described in Rajagopalan plainly cannot have molecular weights as low as 2,000 to 30,000 D.)

It is well established, though, that "[t]he fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." See the M.P.E.P. at § 2144.08(II), *citing In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). Rather, "it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings." M.P.E.P. at § 2144.08(II)(a), *citing In re Brouwer*, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). Moreover, the motivation cannot be based on the relative size of the genus and subgenus unless one of skill in the art could immediately envisage the subgenus based on the reference that describes the genus. M.P.E.P. at § 2144.08(II)(a)(4)(a).

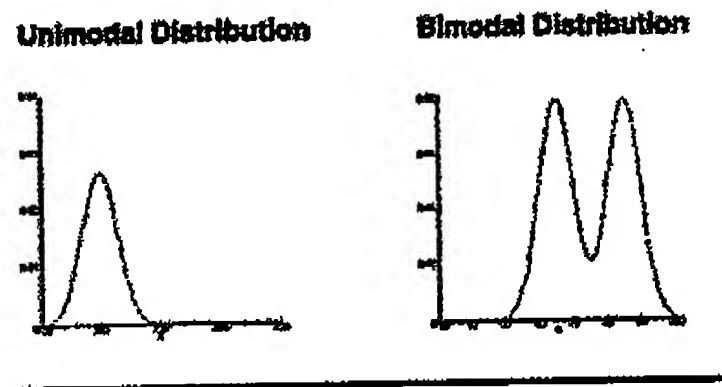
In the present case, Applicant and Examiner are in full agreement that Rajagopalan includes no teaching or suggestion whatsoever to make a bimodal polymer composition. Further to this line of reasoning, Applicant respectfully submits that the subgenus of bimodal compositions that is recited in the present claims is very small and select compared to the broad generic description in Rajagopalan.

In this connection, Applicant will describe the claimed bimodal polymer composition in greater detail with reference to the figure below, which appears in Chapter 9 of *A Judge's Deskbook on the Basic Philosophies and Methods of Science*, by Shirley A. Dobbin and Sophia I. Gatowski, posted on the internet at the URL <http://www.unr.edu/bench/chap09.htm> and accessed on February 15, 2005. Applicant emphasizes that this figure is not an exact representation of the molecular weight

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distribution of the polymer described in Rajagopalan or of the composition that is featured in the claims, but rather is merely illustrative of the concept of unimodal and bimodal distributions.



The molecular weight distribution of a polymer may be graphed on y vs. x axes, where y is a number of molecules and x is a molecular weight. Typically, such a graph shows a bell curve that is centered around the molecular weight that occurs most frequently in the polymer sample. See, for example, the graph above, on the left side of the figure. This type of graph, with a single maximum, is referred to as a "unimodal distribution." The width of the bell curve is related to the polydispersity of the polymer (M_w/M_n).

In contrast, the graph on the right has two maxima. Therefore, it is known as a "bimodal distribution." In the case of the polymer composition that is in the claimed golf ball covers, the first maximum would fall between 2,000 D and 30,000 D on the x axis, and the second maximum would fall between 80,000 D and 500,000 D. The relative areas under the two maxima would be about 5:95 to about 30:70. (See claim 1, lines 20 to 22.)

If the bimodal polymer composition featured in claims 1 and 12 is a subgenus of the generic disclosure in Rajagopalan, it is apparent that it is a very narrow and specific subgenus. Certainly, the bimodal composition in Applicant's claims could not be immediately envisaged by one of skill in the art, based solely on the polymer composition that is described in Rajagopalan. Therefore, a *prima facie* case of

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obviousness cannot be made out over Rajagopalan. Accordingly, Applicant respectfully requests that the rejection of claims 1 and 12 under 35 U.S.C. § 103 be withdrawn upon reconsideration.

Restriction Requirement

Applicant respectfully renews the request that the Restriction Requirement previously issued in the present application be withdrawn upon reconsideration, and that claims 13 through 22 be rejoined with claims 1 through 12 for examination.

Conclusion

As an ancillary matter, Applicant has responded fully to the final Official Action. Therefore, it is believed that no reply is outstanding to a rejection under 35 U.S.C. § 132, and accordingly it is also believed that the present response need not comply with the requirements of 37 C.F.R. § 1.111.

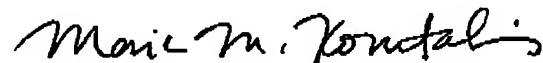
A Petition for an Extension of Time for one month and the required fee for the extension are filed concurrently herewith. Should any further fee be required in connection with the present response, the Examiner is authorized to charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

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In view of the above amendments and remarks, it is felt that all claims are in condition for allowance, and such action is respectfully requested. In closing, the Examiner is invited to contact the undersigned by telephone to conduct any business that may advance the prosecution of the present application.

Respectfully submitted,



MARIA M. KOURTAKIS
ATTORNEY FOR APPLICANTS
Kelly Law Registry on behalf of DuPont Legal
Registration No.: 41,126
Telephone: (302) 892-1004
Facsimile: (302) 992-3257

Dated: February 16, 2005

Enclosure: Supplemental IDS including Form SB/08A